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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,790	06/23/2003	Peter Meerwald	282562US8X	1686
22850 7590 08/22/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER PHAM, THIERRY L				
ART UNIT		PAPER NUMBER		
2625				
NOTIFICATION DATE		DELIVERY MODE		
08/22/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/602,790

Applicant(s)

MEERWALD ET AL.

Examiner

THIERRY L. PHAM

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20, 22-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20, 22-25, 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 5/23/2008.
- Claims 20, 22-25, 27-32 are currently pending, wherein claim 32 is newly added; claims 1-19, 21, 26 have been canceled by applicants.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/23/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20, 22-25, 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer (US 6714209), and in view of McFarland et al (US 6903760).

Regarding claim 23, Valer discloses a system (system as shown in fig. 5) for performing processes used for generating printing data on the basis of which a disk label is creatable (creating disk label, fig. 4), comprising:

- a network capable client (PC 100, fig. 1) configured to locally control/perform (locally generating/creating disk label using local web browser, fig. 4) said processes used for generating printing data on the basis of which a disk label is creatable (disk label, fig. 4);
- and

- a network capable server (server 520, fig. 5) configured to offer functionality directly usable on said network capable client (disk label creating functionality via web browser, fig. 6, col. 2, lines 50-65 and col. 11, lines 5-67), wherein said functionality is adapted to locally control/perform (users locally creating disk label via using web browser, fig. 3-5, col. 11, lines 5-67) said processes used for generating printing data on the basis of which said disk label is creatable, wherein said network capable client and network capable server are connected with each other via a communication network (network, fig. 5), wherein said printing data are generated based on graphic data representing said disk label (Valer also allows users to preview the TOC disk label before printing, col. 3, lines 45-49), wherein, in advance of finalizing said graphic data for said disk label (finalizing before sending to print, fig. 6), a disk label is determined in dependence on a disk category and a disk type (Valer also teaches plurality of disk types including CD, DVD, CD-R, DVD-RAM, and etc, cols. 4-5) selected by a user.

Valer fails to teach and/or suggest a program that has functionalities that control processes for generating print data on a basis of which a disk label is creatable and is installable in client device (e.g. client pc) and does not teach a disk label printing area is determined in dependence on selection by a user of a disk category and a disk type, wherein said category defines overall dimensions for disks of each disk category, wherein from said disk type areas are derivable which are prohibited from being labeled for said disk category, and the printing data is presented to the user at a first resolution and to rescale it to the second/higher resolution.

McFarland, in the same field of endeavor for printing disk labels, teaches a program that has functionalities that control processes for generating print data on a basis of which a disk label is creatable and is installable in client device (*programs for creating disk label can be generated by way of computer program using high level of programming languages such as C++, JAVA, and etc and stored in computer 120, fig. 1. col. 6, lines 25-28*) and a disk label printing area is determined in dependence on selection by a user of a disk category and a disk type (*label page layout is displayed dependence upon the type of disk selected by users, col. 5, 55-67 and col. 8, lines 46-57*), wherein said category defines overall dimensions (*e.g. size of disk media such as*

8cm or 12 cm, col. 5, lines 13-45) for disks of each disk category, wherein from said disk type areas are derivable which are prohibited (*fig. 4 shows there are certain areas that would be outside the label area corresponding to the area of the CD and are blocked from printing and/or not printing on the CD printable area, col. 5, lines 25-30*) from being labeled for said disk category, and the printing data is presented to the user at a first resolution and to rescale (*image rescaling, col. 6, lines 35-40*) it to the second resolution.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify printing system of Valer to include a program that has functionalities that control processes for generating print data on a basis of which a disk label is creatable and is installable in client device (e.g. client pc) and a disk label printing area is determined in dependence on selection by a user of a disk category and a disk type, wherein said category defines overall dimensions for disks of each disk category, wherein from said disk type areas are derivable which are prohibited from being labeled for said disk category, and the printing data is presented to the user at a first resolution and to rescale it to the second/higher resolution because of the following advantages: (1) it allows users to create disk label locally (by installing program at client device) or remotely (using program stored in remote server); (2) automatically displays page layout based upon user's selection of disk type/category (col. 5, lines 55-67) that allows user to create disk label more efficiently/effectively; (3) automatically rescaling the image to a second resolution (size) so the image can fit on a given media size (e.g. 8 cm or 12 cm).

Therefore, it would have been obvious to combine Valer with McFarland to obtain the invention as specified in claim 23.

Regarding claim 20, combination of Valer and McFarland further teach wherein the network client is configured to download an applet from the network capable server, and the applet is used in conjunction with a web browser to select the disk category and disk type in order to generate the graphic data for the disk label. Valer teaches a disk label program using XML format and wherein disk label program as taught by McFarland can be programmed in any high level language including JAVA language, therefore, it would have been obvious to construct Valer's disk label program in a

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different language (for example, JAVA applets as taught by McFarland) so that user can download and install it at their local device.

Regarding claim 22, Valer further teaches the network capable server according to claim 23, wherein printing data being remotely generated by said remote client is received (via network 510, fig. 5).

Regarding claim 24, Valer further discloses the system according to claim 23, wherein said communication network comprises the Internet (Internet 510, fig. 5) and/or an Intranet.

Regarding claim 29, combination of Valer and McFarland further teach the system according to claim 23, wherein said graphic data are generated by graphic tool, which is part of an applet, having a drawing functionality. Valer teaches a disk label program using XML format and wherein disk label program as taught by McFarland can be programmed in any high level language including JAVA language, therefore, it would have been obvious to construct Valer's disk label program in a different language (for example, JAVA applets as taught by McFarland) so that user can download and install it at their local device.

Regarding claims 25, 27-28, 32 recite limitations that are similar and in the same scope of invention as to those in claims 23-24 above; therefore, claims 25, 27-28, 32 are rejected for the same rejection rationale/basis as described in claims 23-24.

Response to Arguments

Applicant's arguments with respect to claim 23 have been considered but are moot in view of the new ground(s) of rejection via using previously cited prior arts of record.

Regarding claim 23, the applicants argued the cited prior arts of record fail to teach and/or suggest the newly added features/limitations.

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In response, the examiner disagrees. Newly added features/limitations as cited 23, 27, and 32 were not included in any of the previous rejected claims. However, upon further consideration of previously cited prior arts of record, McFarland clearly teaches the newly added features/limitations as cited (see rejection above for details).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THIERRY L. PHAM whose telephone number is (571)272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thierry L Pham/
Art Unit 2625

/Dov Popovici/
Primary Examiner, Art Unit 2625